

REMARKS

Applicant has carefully reviewed and considered the Examiner's Office Action dated August 17, 2005, in which claim 30 was neither allowed or rejected by the art of record. Reconsideration is respectfully requested in view of the foregoing amendments and the following comments.

By this Amendment, claim 23 is amended. In particular, claim 23 recites "a unit for inserting coupons into packets", the assembly station includes a pocket and is for receiving a collar of a packet and the universal pickup and application device "conveys the picked-up coupon to a release position which overlies the pocket of the assembly station and the picked-up coupon comes to rest beneath a collar of a packet prior to insertion into the packet." Accordingly, claims 23-30 are pending in the present application.

Claim 23 was rejected under 35 U.S.C. §102(b) as being anticipated by German Patent No. 27 02 482 (hereinafter referred to as "DE '482") as explained in paragraph 2 of the Action. In view of the foregoing amendments to claim 23, it is believed that this rejection is now rendered moot.

Applicants' claimed unit for inserting printed coupons into packets in a packaging machine includes 1(a) first means by which to feed coupons procured as single items ordered in a stack, or 1(b) second means by which to feed coupons obtained as cuts from a continuous strip; 2) an assembly station having a pocket and for receiving a collar; and 3) a universal pickup and application device. As recited in claim 23, the universal pickup and application device picks up an individual coupon with equal facility from either the first or the second feed means at a pickup station and conveys the picked-up coupon to a

release position which overlies the pocket of the assembly station and the picked-up coupon comes to rest beneath a collar of a packet prior to insertion into the packet. The coupon is then inserted into a partly finished cigarette pack (original claim 22).

It appears to be the Action's position that the recitation of the material to be worked upon and the recitation of functional language can be ignored, as noted in the footnotes of the Action. However, it is well known settled patent law that a product may be claimed either structurally or functionally. That is, a patent applicant is free to recite and define elements functionally (by what they do). Further, anticipation requires that every limitation of the claim in issue be disclosed either expressly or under principles of inherency in a single prior art reference. The Board of Patent Appeals and Interferences does not overrule Federal Circuit decisions and those of their predecessor (CCPA) which hold that the single prior art reference must be capable of inherently possessing the functional characteristic relied upon. *In re Robertson*, 169 F.3d 743, 48 USPQ2d 1949 (Fed. Cir. 1999); *In re Schreiber* 128 F.3d 1473, 44 USPQ2d 1439 (Fed. Cir. 1997); *Corning Glass Works v. Sunitomo Electric U.S.A* 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989); *In re Hallman*, 655 F.2d 212, 210 USPQ 609 (CCPA 1981); and *In re Swinehart et al.*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

DE '482 discloses a container labeling machine. This is not a unit for inserting printed coupons into packets in packaging machines as the preamble of claim 23 recites. *Corning Glass Works, supra* held that the preamble may constitute additional structural limitations if the words give "life and meaning" and provide further positive limitations to the recited invention. 9 USPQ2d 1962 at 1966. While DE '482 conveys labels 11 in row and columns on a web 12, transfer unit 14 simply gathers the labels 11 while a

pressure unit applies to labels to the sides of the container. Nowhere does DE '482 disclose either the first feed means (procured as single items from a stack) or the second feed means (obtained as cuts from a continuous strip) as DE '482 simply peels the web from the labels. Accordingly, even under the Action's improper interpretation of the claim limitations, DE '482 fails to disclose each and every recited structural feature.

DE '482 does not inherently possess the characteristics of the recited assembly station having a pocket and for receiving a collar of a packet and the recited universal pickup and application device that picks up a coupon from a feed means and conveys the picked up coupon to a release position which overlies the pocket of the assembly station and the picked up coupon comes to rest beneath a collar of a packet prior to insertion into the packet as described on page 15 of the specification. To the contrary, DE '482 is directed to a machine that places a label over a container and on either side thereof. DE '482 does not have structure or disclosure where a label can be inserted into a container, as the purpose of DE '482 is to provide a label across the container. Accordingly, DE '482 does not have the recited assembly station and universal pickup and application device, which the functional language gives "live and meaning" thereto. DE '482 cannot inherently possess this structure as it is directed to a different type of machine. Accordingly, DE '482 cannot anticipate the claimed invention and withdrawal of this rejection is respectfully requested.

Claims 23 and 25 were rejected under 35 U.S.C. §102(b) as being anticipated U.S. Patent No. 4,198,258 to Glössmann as explained in paragraph 3 of the Action. In view of the foregoing amendments to claim 23, it is believed that this rejection is now rendered moot.

Glössmann, like DE '482, is directed to an apparatus for applying adhesive-coated labels to cigarette packs and does not disclose an apparatus for inserting printed coupons into packets as recited in claim 23. Glössmann does not disclose an assembly station having a pocket and for receiving a packet and a universal pickup and application device that work together so that a coupon is inserted beneath a collar of a packet. Instead, Glössmann labels 4 are delivered into the path of incoming packs 3 by drum 7. That is, the labels 4 disclosed by Glössmann are transferred by a carrier 16 on the perimeter of drum 7. Then, label 4 is disposed across inlet 48B of folding device 48 and the pusher 61 pushes a pack 3 into contact with label 4. There is no disclosure of inserting a coupon or label into a pack as Glössmann only describes an apparatus for applying a label against a pack. Thus, Glössmann fails to disclose a unit for inserting a printed coupon into a packet, the recited universal pickup and application device that is capable of conveying a picked-up coupon to a release position which overlies the pocket of the assembly station so that the picked up coupon comes to rest beneath a collar of a packet prior to insertion into the packer. Glössmann's apparatus is not capable of the above structural elements defined in functional terms. Accordingly, Glössmann cannot anticipate the claimed invention and withdrawal of this rejection is respectfully requested.

Claims 23 and 27-29 were rejected under 35 U.S.C. §102(b) as being anticipated U.S. Patent No. 3,834,963 to Hoffman as explained in paragraph 4 of the Action. In view of the foregoing amendments to claim 23, it is believed that this rejection is now rendered moot.

Hoffman is directed to a machine for applying labels onto the side of a container. Nowhere does Hoffman disclose a unit for inserting a label or coupon into a container or

a packet as claimed by Applicants. Thus, Hoffman fails to disclose the type of unit and the structure for inserting a coupon as required by Applicants' claims. As recited in Applicants' claim 23, the picked-up coupon comes to rest beneath a collar of a packet at the assembly station. It is the Action's mischaracterization of Hoffman that suggests that Hoffman discloses an assembly station with a pocket. To the contrary, Hoffman discloses a drum 96 and a "can engaging pad 102". Nowhere does Hoffman disclose structure for receiving a packet in addition to the pocket so that the label can be inserted beneath the collar of the packet at the pocket prior to insertion into the packet. Nor can the structure of Hoffman be said to inherently possess a label that can come to rest beneath a collar of a packet as the label 56 disclosed by Hoffman moves with the can until the can and label are released. Accordingly, Hoffman fails to disclose each and every limitation (both structural and functional) as required by U.S. Patent law and withdrawal of this rejection is respectfully requested.

With respect to dependent claims 27-29, the universal pickup and application device includes at least one pickup assembly. While the Action indicates that reference numeral 151 of Hoffman corresponds to the recited universal pickup and application device, it is silent about the recited "at least one pickup assembly". Reference numeral 151 of Hoffman cannot be both recited elements. Thus, Hoffman at least fails to disclose the recited pickup assembly and the recited carrier upon which the pickup assembly is located. Thus, it is believed that Hoffman cannot anticipate claims 27-29 and withdrawal of this rejection is respectfully submitted.

Claims 24 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Glössman in view of European Patent No. 0 370 633 to Bright for the reasons set

forth in paragraph 3 spanning pages 4-5 of the Action. In view of the foregoing amendments to claim 23, it is believed that this rejection is now rendered moot.

Dependent claim 24 recites that “the first and second feed means are mutually interchangeable”. That is, the universal pick up and application device is able to pick up coupons from the first feed means, as well as from the second feed means. Glössmann discloses labels 4 in a magazine stack. Glössmann does not suggest that another feed means could be used, or that the alleged universal pick up and application device can use either type of feed means. Instead, Glössmann discloses a single type of label feed means.

The secondary reference to Bright discloses two types of feed means; but discloses an entirely different structure than that disclosed by Glössmann. Thus, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to modify the structure of Glössmann to be “mutually interchangeable”. It is unclear how one of ordinary skill in the art would replace the feed of Glössmann with the feed types taught by Bright, as Bright discloses modules that are used within its disclosed structure. Thus, it is respectfully submitted, one of ordinary skill in the art would not have been motivated to take part of Bright's structure to achieve Applicants' invention.

In view of the above, it is submitted that one of ordinary skill in the art would not have been motivated to combine the cited prior art to achieve Applicants invention as none of the prior art references teaches the insertion of coupons into a packet. It is only Applicants' own disclosure that addresses the insertion of coupons into a packet. Thus, it is respectfully submitted that the Action relies on impermissible hindsight to modify the base reference as the cited references are not directed to the claimed invention.

Reconsideration and allowance of claims 23-30 of the present application are respectfully requested.

If the Examiner believes that a conference would help to advance the prosecution of the present application, she is requested to telephone the undersigned at the number below.

Respectfully submitted,

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